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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
PAOLO BARACCHINI, ET AL. : EXAMINER: OH, S.
SERIAL NO: 09/419,891 :
FILED: OCTOBER 18, 1999 : GROUP ART UNIT: 1615
FOR: THERMOINSULATING MAT OF :
MINERAL FIBERS WITH RANDOM
ORIENTATION

JUL 29 2004

REQUEST FOR RECONSIDERATION CH CENTER 1600/2900

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Office Action dated January 26, 2004, Applicants request the reconsideration of the rejection of claims 5-7, for the reasons set forth below.

Claims 5-7 recite a process for manufacturing a thermoinsulating flexible mat of mineral fibers having quasi-random orientation, comprising a first step of longitudinally compressing an initial felt to produce a felt having an undulated fiber structure, and a second step of longitudinal compression of the felt to produce a compressed mat having a random arrangement of the fibers. This two step method is not taught or suggested in the prior art.

Claims 5-7 were rejected under 35 U.S.C. §103 as being obvious over U.S. patent 4,632,685 (Debouzie et al). Applicants wishes to thank Examiners Oh and Azpura for the courtesy of an interview on April 29, 2004, at which time the outstanding rejection was discussed. In particular, Applicants pointed out that Debouzie et al fails to teach a process including a first step of longitudinal compression to produce a felt having an undulating fiber

structure, followed by a second step of producing random orientation of the fibers. This is not taught by Figures 1-3 of the reference, since Figures 1-3 do not show a sequence of steps in the manufacture of a fiber felt of Debouzie et al, but instead respectively show a sample of felt without longitudinal compression (Figure 1); a sample felt pressed by *prior art* techniques (Figure 2); and a sample felt compressed according to the invention of Debouzie et al (Figure 3). Indeed, the prior art of Figure 2 is criticized in Debouzie et al as being undesirable (column 5, lines 11-13).

The Examiner has alleged that the burden is upon Applicants to show criticality for features such as fiber diameter, density and speed ratio of the conveyors, since these are features that “may be easily adjusted by one of ordinary skill in the art with routine experimentation.” However, as noted above, the shortcomings of Debouzie et al are more fundamental – a failure to disclose a step of producing a felt having an undulated fiber structure, followed by a step of producing a mat having a random arrangement of fibers. Applicants therefore respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.


Additionally, Applicants are submitting the expert declaration of Valérie Dupouy. According to the Dupouy declaration, there would be no pleating in any embodiment of the process disclosed in Debouzie et al (paragraph 9). Therefore, the claimed process whereby a first step of longitudinally compressing an initial felt produces a felt having an undulated fiber structure, and a second step of longitudinal compression of the felt produces a compressed mat having a random arrangement of the fibers would not be inherently present in Debouzie et al.

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Applicants therefore request that the outstanding rejection be withdrawn and that a
Notice of Allowability be forthcoming.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Robert T. Pous
Registration No. 29,099

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